

REMARKS

In the final Office Action mailed June 18, 2009 from the United States Patent and Trademark Office, claims 14-20 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter, claims 1-4, 9, 10 and 14-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,982,804 to Frolik et al. (hereinafter "Frolik"), in view of U.S. Patent No. 6,603,565 to Scheidig et al. (hereinafter "Scheidig"), and U.S. Patent No. 7,196,803 to Simpson et al. (hereinafter "Simpson"), claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Frolik, Scheidig, and Simpson in view of U.S. Patent No. 6,111,654 to Cartier et al. (hereinafter "Cartier"), claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Frolik, Scheidig, Simpson, and further in view of U.S. Patent No. 5,999,707 to Taniguchi et al. (hereinafter "Taniguchi"), claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Frolik, Scheidig, and Simpson in view of well-known prior art, claims 11-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Frolik in view of Scheidig, U.S. Patent No. 6,026,436 to Hawes (hereinafter "Hawes") and Simpson.

Applicant has amended the claim set to more distinctly define over the cited references and to address the Section 101 rejections. Support for the amendments may be found at least at page 6 lines 3-5, page 6 lines 12-14, page 10 line 21 through page 11 line 2, and page 21 lines 4-7. Applicant therefore respectfully provides the following:

Rejections under 35 U.S.C. § 101:

In the Office Action, claims 14-20 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claim 14 has been amended to recite a "tangible computer

readable medium” and therefore no longer encompasses a communication connection. Applicant therefore respectfully requests removal of the rejections.

Rejections under 35 U.S.C. § 103(a):

M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: 1) ascertaining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) In addition, M.P.E.P. §§ 2141 and 2142 set forth that “the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (Citing *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007).)

For a rejection under Section 103 to stand, it must explicitly set forth 1) factual findings showing that each claim element was known in the art at the time of the invention, and 2) factual findings showing that one of ordinary skill in the art, at the time of the invention, would have found it obvious to modify or combine the teachings to arrive at the claimed invention. (See, for example, the enumerated required articulations set forth in M.P.E.P. § 2143 for each lettered rationale.) Applicant respectfully submits that the references in the Office Action, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein.

Independent claim 1 requires: “In a printing environment, a method for specifying application specific printing requirements for an arbitrary printing device, the method comprising: providing a printing device having a plurality of default device setting sets stored in memory of the printing device; configuring one of the default device setting sets by selectively

associating an application specific name with one of: (i) a standard default setting set; and (ii) an application specific default setting; identifying which of the default device setting sets are to be used in executing a particular print job; and executing the print job at the printing device using the identified default device setting set without further prior preparation of print data of the print job regardless of the default print setting set selected.” Such limitations are not taught by the combination of Frolik, Scheidig, and Simpson.

From the “Response to Arguments” section of the Office Action, it appears that Simpson’s disclosure of generating a print job with the previously-used limitations of “rendering the print job.” (See Office Action, discussion spanning pages 2-3.) The amended claim limitations clarify that executing the print job at the printing device using the identified default device setting set (not generation of the print job at some other stage as discussed in Simpson) occurs without further prior preparation of print data of the print job regardless of the default print setting set selected. Therefore, Applicant respectfully submits that Simpson does not disclose such portions of claim 1, which are also not disclosed by any of the other cited references.

As none of the cited references teach the recited claim limitations, the cited references, when combined, also fail to teach the recited limitations. Additionally, one of skill in the art would not have found it obvious to modify or combine reference teachings in the manner suggested in the Office Action. Therefore, one of skill in the art would not have found the claimed invention of claim 1 obvious over the cited references, given the differences between the limited disclosure of the cited references and the claimed invention.

Independent claim 14 contains similar limitations to those discussed above with respect to claim 1, and is therefore similarly allowable. Claims 2-10 and 15-20 depend from one of allowable claims 1 and 14, respectively, and are therefore similarly allowable.

Independent claim 11 also includes similar limitations to those discussed above, and Hawes also fails to teach such limitations. Therefore, one of skill in the art would not have found the claimed invention of claim 11 obvious over the cited references, given the differences between the limited disclosure of the cited references and the claimed invention. Claims 12-13 depend from claim 11 and are therefore also allowable.

Applicant incorporates the comments from the last prior response by reference, as though set forth herein in full, and does not waive the applicability of such arguments. In further response to the issues raised in the office action with respect to Applicant's prior arguments, Applicant respectfully notes that Frolik teaches that an application must insert the printer settings in a format compatible with the print job, thus requiring additional processing before execution of the print job by the printing device. Applicant further notes that Simpson fails to disclose what, if any preparation of the print job occurs after the print job is sent to the web server. Finally, regarding the limitations of claims 4 and 11, the Office Action posits that a "document in the system of Frolik . . . is inherently identified by its file name." (Office Action, middle of page 4.) Regardless of whether a document in Frolik is inherently identified by its file name, a file name is not one of the characteristics recited by these claims. Thus, the Office Action still fails to show that selecting a set of default printing sets based on a characteristic recited in the claims would have been obvious based on the disclosure of Frolik. For this additional reason, claims 4 and 11 are not made obvious by the cited references.

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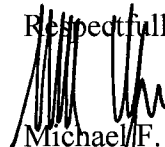
Applicant therefore respectfully requests removal of all rejections under 35 U.S.C. § 103(a).

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

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Respectfully submitted,



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